

Serial No.: 10/591,411

REMARKS

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims is not more than three, and the total number of claims is not more than originally filed.

Amendment to the Claims

Applicants respectfully request entry of the above Amendment to place this U.S. Patent Application in better form for examination and prosecution before the U.S. Patent and Trademark Office.

The claims have been amended to more definitely and fully claim the subject matter of Applicants' invention. Claim 1 has been canceled and replaced with Claims 24 and 25. Applicants urge that the above Amendment introduces no new matter into this U.S. Patent Application.

Restriction/Election

Restriction has been required between one of the following allegedly distinct inventions.

Group I: Claims 1-16, 22, and 23, drawn to a fluorocarbon emulsion; and
Group II: Claims 17-21, drawn to a method of producing a fluorocarbon emulsion.

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Applicants hereby elect Group I with traverse.

According to PCT Rule 13.2 the requirement of unity of invention referred to in Rule 13.1 “shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features,” which are “those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” 37 CFR 1.475(b)(2) states that a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to a product and a process for manufacturing of said product. This is the case in Applicants’ claims, which are drawn to a fluorocarbon emulsion and a method of making the fluoropolymer emulsion.

As best understood from the Office Action, the Examiner’s position is that because perfluorooctylbromide is known for use as a blood substitute, the “compounds of the claims” lack any special structural element qualifying as special technical feature that defines a contribution over the prior art. However, the Office Action does not properly analyze the invention, as Applicants’ claimed invention is an emulsion containing several components; the invention is not merely the use of perfluorooctylbromide. This is but one element recited in claims of the subject Patent Application. Applicants respectfully assert the Restriction Requirement should be withdrawn because of this incomplete, and thus incorrect, consideration of the claimed invention.

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Applicants note that all claims were found to have unity of invention, as well as novelty and inventive step, by the International Searching Authority.

The Office Action further alleges there is more than one species within the claims of Group I. Applicants do not understand what the alleged species are and thus cannot make an election. At page 3, the Office Action states the example species are “perfluorodecaline or related compounds” or “perfluoro-1-propyl-3,4-dimethylpyrrolidone or related compounds.” It is not understood what the Office Action means by “related compounds.” Referring specifically to perfluorodecaline, the undersigned does not perceive any “related compound” that would be considered a separate species to perfluorodecaline. Perhaps the above Amendment renders the species requirement moot. The Examiner is invited to contact the undersigned by telephone to discuss any remaining species requirement.

Furthermore, the species restriction in the Office Action is simply a mere statement that there are species, and no reasoning is provided as to why the alleged species are not linked as to form a single general inventive concept. Therefore, the species restriction is improper.

As a species election is required to avoid abandonment, Applicants make a preliminary election of the emulsion species in Claim 25, and reserve the right to modify the species election upon clarification of the Restriction Requirement by the Examiner. All claims read on or are generic to the elected species.

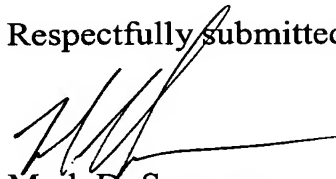
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Conclusion

Applicants sincerely believe that this U.S. Patent Application is now in condition for examination and prosecution before the U.S. Patent and Trademark Office.

Applicants intend to be fully responsive, and request a telephone interview if any further issue remains.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Swanson', written over a horizontal line.

Mark D. Swanson
Registration No. 48,498

Pauley Petersen & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60169
TEL (847) 490-1400
FAX (847) 490-1403